

APPLICANTS: HERSHKOVITS, Yehuda et al.  
SERIAL NO.: 09/986,452  
FILED: November 8, 2001  
Page 4

#### **REMARKS**

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

#### **Status of Claims**

Claims 29-34 are pending in the application.

Claims 29-34 have been rejected.

Claims 29-33 have been amended.

Claims 29-33 have been voluntarily amended for clarification only. This amendment does not narrow the scope of the claim. The amended claim is not subject to the complete bar against the use of the Doctrine of Equivalents as outlined in *Festo Corporation v. Shoketsu Kinsoku Kogyo Kapushiki Co., Ltd. a/ka/ SMC Corporation and SMt Pneumatics, Inc.*, as the amendment does not narrow the scope of the claim.

Applicants respectfully assert that the amendments to the claims add no new matter.

#### **CLAIM REJECTIONS**

##### **35 U.S.C. § 103 Rejections**

In the Office Action, the Examiner rejected claims 29-34 under 35 U.S.C. § 103(a) as being unpatentable over Pecone (US 2003/0065733, hereinafter the “Pecone reference”) in view of Wachel (US 2002/0078395, hereinafter the “Wachel reference”).

APPLICANTS: HERSHKOVITS, Yehuda et al.  
SERIAL NO.: 09/986,452  
FILED: November 8, 2001  
Page 5

For at least two reasons that follow, Applicants respectfully traverse the rejection of claims 29-33. First, Pecone cannot serve as a reference under Section 103(a) because Applicants are able to antedate the reference by demonstrating a date of invention for the claimed invention which is prior to the filing date of the Pecone reference. Secondly, even if the Pecone reference were proper, the Examiner has not established any motivation to combine the two cited references and thus has not established a *prima facie* case of obviousness based on the two cited references.

#### I. Applicants Have Sworn Behind the Pecone Reference

Section 103(a) states that “[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.” (emphasis added).

Under 37 C.F.R. § 1.131(a), an applicant may demonstrate invention prior to the effective date of the reference by submitting an appropriate oath of declaration. Section 1.131(b) provides that showing of facts shall be such as to establish reduction to practice prior to the effective date of the reference.

The effective reference date of the Pecone reference is its filing date, September 28, 2001. As established by the Declaration of Yehuda Hershkovits and Yoram Stettiner, submitted herewith, the present invention was reduced to practice at least as early as August 1, 2001, well before the effective filing date of the Pecone reference.

As recited in the accompanying declaration, the Applicants had disclosed the present invention to their attorneys, Mr. Jerome Smith and Mrs. Heidi M. Brun, prior to the effective date of the Pecone reference, sometime in 2001. Subsequently, Mrs. Brun had a draft of a patent application describing the presently claimed invention prepared according to the disclosure of the invention, and in an e-mail transmission dated August 1, 2001, Mrs. Brun sent the draft application to Applicants for their approval. The draft application shows that Applicants were in possession of the claimed invention as of August 1, 2001, the date by

APPLICANTS: HERSHKOVITS, Yehuda et al.  
SERIAL NO.: 09/986,452  
FILED: November 8, 2001  
Page 6

which they had sufficiently described the invention to enable one of ordinary skill in the art to make and use the invention.

Applicants have thus demonstrated that the date of invention preceded or antedates the effective date of the Pecone reference. As such, Applicants respectfully request that Pecone be removed as a reference.

## II. Claims 29-34 are Patentable over the Pecone reference and the Wachel reference

In the Office Action, the Examiner rejected claims 29-34 under 35 U.S.C. § 103 (a) as being unpatentable over the Pecone reference in view of the Wachel reference. For the reasons that follow, Applicants traverse the rejection.

As discussed further below, the Examiner has not established where in the references there may be found a motivation to combine them.

### No Suggestion or Motivation to Combine Pecone and Wachel

It is well established that in order to successfully assert a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP § 2143.01).

The Examiner has rejected claims 29-34 as obvious based on the Pecone reference as combined with the Wachel reference. Such suggestion or motivation is lacking with regard to Pecone and Wachel.

The primary reference, the Pecone reference, teaches:

A network storage controller for transferring data between a host computer and a storage device, such as a redundant array of inexpensive disks (RAID), is disclosed. The network storage controller includes at least one channel interface module which is adapted to be connected to the host computer and storage device. The channel interface module is connected to a passive backplane, and selectively transfers data between the host computer and storage device and the passive backplane. The network storage controller also

APPLICANTS: HERSHKOVITS, Yehuda et al.  
SERIAL NO.: 09/986,452  
FILED: November 8, 2001  
Page 7

includes at least one controller memory module, attached to the passive backplane. The controller memory module communicates with the channel interface module via the passive backplane, and processes and temporarily stores data received from the host computer or storage device. In applications where redundancy is required, at least two controller memory modules and at least two channel interface modules are used. The controller memory modules may mirror data between one another using the passive backplane and a shared communication path on the channel interface modules, thereby substantially avoiding the use of host or disk channels to mirror data. The channel interface modules are operable to selectively connect the host computer or storage device to one or more controller memory modules. The controller memory modules may include a DMA engine to facilitate the transfer of mirrored data. (The Pecone reference, Abstract)

The Pecone reference further teaches connecting a computer with a storage device using a passive backplane having a number of data buses, which may be PCIX buses. (paras. 13, 16). Thus, as correctly pointed out by the Examiner, the Pecone reference does not teach interconnection of the rear I/O card and the second front card or rear card via a through connection.

Furthermore, Applicants respectfully assert that the Pecone reference does not deal with telecommunications transmissions, as stated in the pending claims at all.

Despite the unrelated field to which the disclosure of Pecone is directed, the Examiner has stated that the channel interface module (CIM, see Fig. 6, reference 136, 140) corresponds to the rear card of the pending claims and that the controller memory modules (CMM, see Fig. 6, references 104, 108). However, Applicants respectfully submit that the CIM and CMM are not identical or analogous to a rear card and front card at least for the reason that the CIM and CMM do not have the relationship claimed in pending claim 1.

The Pecone reference states that “[e]ach CMM has two backplane interfaces. The system has a passive bus backplane, which has two buses for each CMM. In the embodiment shown, the passive bus backplane uses next generation [PCIX] buses, although it will be understood that any bus technology may be used . . .” (p. 4 col. 1). Moreover, “[e]ach CIM has two CIM bus interface ports. On each CIM, one CIM bus interface port connects to one bus which is connected to CMM-A, and one CIM bus interface port connects to one bus

APPLICANTS: HERSHKOVITS, Yehuda et al.  
SERIAL NO.: 09/986,452  
FILED: November 8, 2001  
Page 8

which is connected to CMM-B via CIM bus connections." (p. 4 col. 2). That is, each CMM is connected to a bus, allowing each CIM to communicate with each CMM.

Unlike Pecone, according to the present claim, the rear card is connected via a through connection to its corresponding front card, when no failure indication is received. Thus, there are numerous differences between the present claims and Pecone. For example, there is no association between each CMM and each CIM; there may be any number of CMMs and any number of CIMs. In contrast, according the claims, said rear card has a corresponding front card.

While not necessary for purposes of patentability, the claims have amended to clarify this distinction. That is, the claims clarify that the rear card is connected to a front card via a through connection when no failure indication is received. This is nowhere disclosed, implicitly or explicitly, by the Pecone reference. On the contrary, Pecone discloses connecting the CMMs to the CIMs by a bussed connection, not a through connection. Nor is there any suggestion in Pecone to modify the teachings to connect a CIM to a CMM via a through connection.

The secondary reference, the Wachel reference teaches:

A method of improving network interface reliability uses a fail-over mechanism. When one network card becomes disabled, a second network card takes its place. A mid-plane separates the network card into a transition portion and a main portion. Cables are connected to the transition portion, and allows input and output from a particular network card to be re-routed to another network card without the need to physically alter the external cables. (the Wachel reference, Abstract).

To begin with, it would not have been obvious for one of ordinary skill in the field of the present invention to combine the teachings of the Pecone reference (Modular Architecture for a Network Storage Controller) with the teachings of the Wachel reference (Network Interface Reliability Using a Fail-Over Mechanism).

Moreover, the two references teach away from each other. Whereas the Pecone reference teaches connections of front cards as shown above using only PCI busses, the Wachel reference discusses through connections via the midplane:

APPLICANTS: HERSHKOVITS, Yehuda et al.  
SERIAL NO.: 09/986,452  
FILED: November 8, 2001  
Page 9

“...a transition [rear] card 106a is coupled to network I/O 108a via cable interfaces. Transition [rear] card 106a is also coupled to main [front] card 104a via the midplane 102 which allows I/O signals to be passed through from one side to the other. Midplane 102 may also allow signals to be routed to other transition or main cards plugged in to the chassis 100. In one embodiment, connectors 110 between transition [rear] cards may also be employed so that common signals are provided to multiple transition [rear] cards. Similarly, transition [rear] card 106b is coupled to network I/O 108b and to main [front] card 104b via the midplane 102, and so forth.” (the Wachel reference, paragraph 15, emphasis added).

Finally, the motivation cited by the Examiner, i.e., “[i]t would have been obvious to one skilled in the art at the time of the invention to apply a midplane with through connections as taught by Wachel to the modular architecture taught by Pecone for the purpose of simplifying maintenance as suggested by Wachel” is improper. The Examiner has impermissibly used hindsight to motivate the combination of the Pecone reference and the Wachel reference without any suggestion of benefit from the references themselves.

Therefore, one of ordinary skill would not find it obvious to combine the references; that is, the systems provided by the Pecone reference and the Wachel reference are not complementary, but alternative to each other. Only by impermissibly use of hindsight would one of ordinary skill arrive at the present invention. Therefore, the Pecone reference and the Wachel reference combined do not properly obviate claims 29-34. Accordingly, the rejected claims are patentable over the prior art of record.

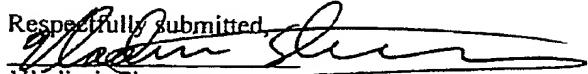
Applicants note that none of the amendments to the claims herein are in response to the above discussed prior art rejections.

In view of the foregoing amendments and remarks, the pending claims are believed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

APPLICANTS: HERSHKOVITS, Yehuda et al.  
SERIAL NO.: 09/986,452  
FILED: November 8, 2001  
Page 10

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